



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,969	01/21/2000	William J. Baer	STL000017US1	5170

23373 7590 12/02/2003

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/488,969

Applicant(s)

BAER ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: original application filed 01/21/2000; IDS filed 09/30/2003.
2. Claims 1-15 are currently pending in this application. Claims 1, 6 and 11 are independent claims.

Specification

3. The abstract of the disclosure is objected to because it exceeds the limit of 150 words. Correction is required. See MPEP § 608.01(b).
4. The disclosure is further objected to because information regarding related applications cited at page 1 has not been updated.
5. Although applicant provided **APPENDIX A** [A-1 -- A-63] along with the specification, applicant has failed to submit "**microfiche appendix**". Appropriate correction required.

This application contains an appendix consisting of a computer program listing of more than ten (10) pages. In accordance with 37 CFR 1.96(c), a computer program listing contained on more than ten (10) pages, must be submitted as a "**microfiche appendix**" conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the specification (see 37 CFR 1.77(a)(6)). Accordingly, applicant is required to cancel the computer program listing appearing in the current appendix to the specification, file a "**microfiche**

Art Unit: 2176

appendix" in compliance with 37 CFR 1.96(c), and insert an appropriate reference to the newly added "**microfiche appendix**" at the beginning of the specification.

Further examiner notes that in the specification several places containing computer program listing for example pages 119-147, 113-114, 103-105, 85-98, 62-77, 56-57, 47-53, and 32-36. Applicant hereby required to submit computer program listing in "microfiche appendix" as stated above.

Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated **Prinzing** (U.S. 6,592,628 – filed 02/1999).

As to independent claim 1, Prinzing teaches a method for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository, each content object comprising a plurality of content entities, some of the content entities being prerequisites to others of the content entities (*the content of a document ... content can be text, alphanumeric data, or any other information contained in a document ... stored in a storage area; Abstract*), comprising the steps of:

Upon addition or removal a content entity to the compilation, determining if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entity (*the manipulation of content in the storage area includes inserting content in the content entity, removing content from the content entity ... The information retrieved from the element entities is used to manipulate the content stored in the storage area associated with the content entity; col.2, lines 21-67 & col.3, lines 27-58*).

As to dependent claim 2, Prinizing teaches one or more of the prerequisites are conditional (*col.5, lines 2-21*).

As to dependent claim 3, Prinizing teaches the conditions for applying a prerequisite are defined in one or more rules (*col.5, lines 35-37*).

As to dependent claim 4, Prinizing teaches in the case of more than one rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller set of rules (*col.5, lines 35-57*).

As to dependent claim 5, Frinzing teaches the step of rewriting any negative rules as positive rules (*col.5, lines 49-64*).

Independent claim 6 is directed to a program storage device for implementing the method of claim 1, and is similarly rejected under the same rationale.

Dependent claims 7-10 include the same limitations as in claims 2-5, and are similarly rejected under the same rationale

Independent claim 11 is directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale.

Dependent claims 11-15 include the same limitations as in claims 2-5, and are similarly rejected under the same rationale

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pajak et al.	U.S Patent No. 5,388,196	issue dated: Feb. 7, 1995
Rowe et al.	U.S Patent No. 5,737,599	issue dated: Apr. 7, 1998
Nagasshima et al.	U.S Patent No. 5,778,398	issue dated: Jun. 7, 1998
Yoshioka et al.	U.S Patent No. 5,909,688	issue dated: Jun. 1, 1999
Pool et al.	U.S Patent No. 6,006,242	issue dated: Dec. 21, 1999
Tanaka et al.	U.S Patent No. 6,182,082	issue dated: Jan. 30, 2001

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Art Unit: 2176

Any response to this action should be mailed to:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.

OFFICIAL faxes must be signed and sent to (703) 872-9306.

NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen
November 21, 2003


JOSEPH H. FEILD
PRIMARY EXAMINER